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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/434,382	11/05/1999	SEAN V. TAVTIGIAN	2318-247	3879

6449 7590 06/18/2002

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EXAMINER

HUNT, JENNIFER ELIZABETH

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 06/18/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.
09/434,382

Applicant(s)
Tavtigian et al.

Examiner
Jennifer Hunt

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1642



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Apr 2, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s):
The rejection under 35 USC 112 first paragraph for lack of enablement is withdrawn in light of applicant's arguments.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attachment

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1-3, 11-15, 61-63, and 67-77

Claim(s) objected to: _____

Claim(s) rejected: 10, 25, 64-66, and 78

Claim(s) withdrawn from consideration: 16-24 and 27-60

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

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Attachment to Advisory

Claims 1-3, 10-25, 27-78 are pending in the application. Claims 16-24 and 27-60 have been withdrawn from consideration by the examiner, as they are drawn to a non-elected invention. Claims 1-3, 10-15, 25, and 61-78 are pending and under consideration.

Claim Rejections Maintained

1. The rejection of claims 10, 25, 64-66, and 78 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention (the written description rejection) is maintained for reasons of record.

As set forth in the previous office action, claims 10, 25, 64-66 and 78 are broadly drawn nucleic acids of any size, including mutants, modified forms, and variants thereof, which contain a part of SEQ ID NO: 1, or the nucleic acid sequence encoding SEQ ID NO:2. The claims are drawn to a polynucleotide of any size which is only defined by a small number of nucleic acid residues, hence the claims are drawn to nucleic acid sequences which minimally contain only portions of SEQ ID NO:1, or the nucleic acid sequence encoding SEQ ID NO:2. Thus the claims are drawn to a large genus of molecules. In the case of small identified nucleic acid sequences claimed with open language, the genus of the polynucleotides comprising a partial sequence

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encompasses a variety of subgenera with widely varying attributes. The specification discloses only the structural features of one species, the polynucleotide of SEQ ID NO:1 and the polypeptide of SEQ ID NO: 2, which is encoded by SEQ ID NO:1.

Thus the specification lacks information to lead one of ordinary skill in the art to understand that the applicant had possession of the broadly claimed genus of polynucleotides at the time the instant application was filed.

Applicant argues that the application as originally filed definitely contemplates probes of at least 8 nucleotides, which are based on the HPC2 gene. Applicant further argues that one skilled in the art of DNA probes and primers would know what DNA probes and primers are, and further would recognize that applicant had possession of these probes and primers which are claimed, providing a brief discussion on the structure, derivation, and function of probes and primers as support for this argument. Applicant's arguments filed 4-02-2002 have been fully considered but they are not persuasive.

Applicant's arguments are not commensurate in scope with the claims, which are not limited to sequences which only contain parts of SEQ ID NO:1, due to the "open" claim language. The claims as recited encompass nucleotide sequences which only share a small region of homology with the disclosed polynucleotide. To meet the limitation of the claims, a polynucleotide need only have 8 or 13 nucleotides in common with the disclosed sequence. However, due to the open language in the claim, the claimed polynucleotides could be much longer than the 8 or 13 contiguous nucleotide which hybridize to the disclose SEQ ID NO:1.

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Thus the claimed polynucleotides encompass a broad genus of molecules (any polynucleotide, regardless of size or function, which shares a region of homology with SEQ ID NO:1 which is 8 or 13 nucleotides long). The specification only discloses SEQ ID NO:1 and thus does not provide written description for the broadly claimed polynucleotides. It is noted that the addition of functional language, or claiming the probes and primers using closed language would likely bring favorable consideration.

Claims 1-3, 11-15, 61-63, 67-77 are allowed. Claims 10, 25, 64-66 and 78 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Hunt, whose telephone number is (703) 308-7548. The examiner can normally be reached Monday through Thursday 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached at (703) 308-3995. The fax number for the group is (703) 305-3014 or (703) 308-4242.

Communications via internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**anthony.caputa@uspto.gov**].

All internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists the possibility that

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sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist, whose telephone number is (703) 308-0196.

Jennifer Hunt

June 6, 2002


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